

REMARKS

This amendment adds, changes, and/or deletes claims in this application. Specifically, claims 32, 40, 41, 51 and 55 are amended. A complete listing of the claims is set forth above. Upon entry of these amendments, claims 29-33 and 39-60 will be pending. Applicant respectfully requests reconsideration of these claims in view of the following remarks.

September 8th Telephone Conference with Examiner

On September 8, 2004, Examiner Kallis contacted the undersigned to discuss the status of the application in view of the response filed June 15, 2004. Examiner Kallis proposed amendments to the claims that would place the claims in condition for allowance, subject to a possible interference. The foregoing claim amendments make the amendments proposed by Examiner Kallis during the September 8 telephone conference and are believed to place the claims in condition for allowance, notwithstanding the Restriction Requirement issued on September 16, 2004.

September 16th Restriction Requirement

On September 16, 2004, Examiner Kallis issued a Restriction Requirement restricting the claims of the application under the PCT Unity of Invention rules in view of a publication by Dolferus et al. Applicant respectfully objects to the manner in which this Restriction Requirement was issued.

First, Applicant believes that it was improper for the Examiner to issue the Restriction Requirement without providing written notice of the status of the rejections made in the March 15, 2004 Office Action in view of Applicant's response filed June 14, 2004. Although the Examiner indicated, during the September 8th telephone conference, that Applicant's response overcame the pending rejections, Applicant has not been provided with official written notice to that effect.

Second, Applicant objects to the timing of the Restriction Requirement, as it was issued after several years of prosecution on the merits, after the issuance of and responses to numerous non-final and final Office Actions on the merits and several in-person interviews with different examiners who have examined this application. Given the in-depth substantive examination of all of the pending claims that has occurred already, the issuance of a Restriction Requirement at this time only serves to delay prosecution and increase the burden on Applicant.

Finally, the extreme delay in issuing this Restriction Requirement causes great prejudice to Applicant by shortening the effective patent term of any patent issuing from a divisional application filed to pursue the non-elected claims. The term of such a patent will be measured from the June 1999 filing date of the instant application, which means that five years of patent term already are lost. In view of this prejudice and the absence of any burden on the Examiner to continue to examine all of the pending claims in the present application, Applicant respectfully urges that the Restriction Requirement be reconsidered and withdrawn.

Response to Restriction Requirement

In response to the Restriction Requirement, Applicant elects the claims of Group I for prosecution in the instant application. As explained in more detail below, this election is made with traverse to the extent that it is based on an allegation that the special technical feature of the claims of Group I lacks novelty in view of Dolferus et al. Applicant reserves the right to pursue the subject matter of the non-elected claims in one or more divisional applications with the same rights of priority as the instant application.

The claims of Group I (claims 29-53) are directed to a method of increasing a plant's tolerance to hypoxic conditions comprising transforming a plant with an expression system comprising a nucleic acid molecule encoding a plant nonsymbiotic hemoglobin, and to plants produced by that method. *See, e.g.*, claims 39 and 51. Such a method and plants are not taught or suggested by Dolferus. Although Dolferus states that "constructs overexpressing [an *Arabidopsis* non-symbiotic haemoglobin gene] are being introduced into *Arabidopsis*" (page 29, col. 1), Dolferus does not even predict that such transformations will result in a plant that exhibits increased tolerance to hypoxic conditions, as recited in the instant claims. Indeed, Dolferus states that the transformations were being conducted "in an attempt to determine the primary function of haemoglobin in plants," *i.e.*, to test Dolferus' hypothesis that "haemoglobin plays a role as an oxygen carrier." Because Dolferus provides no teaching or guidance relating to a method for increasing a plant's tolerance to hypoxic conditions, it does not defeat the novelty of the special technical feature of the claims of Group I.

In view of the foregoing, Applicant respectfully urges the Examiner to reconsider and withdraw the Restriction Requirement and promptly issue a notice that the claims are in condition for allowance.

Should there be any questions regarding this submission, or should any issue remain, the Examiner is invited to contact the undersigned attorney at the telephone number set forth below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date October 14, 2004

By Courtenay C Brinckerhoff

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4094
Facsimile: (202) 672-5399

Courtenay C. Brinckerhoff
Registration No. 37,288